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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,480	03/27/2001	Ronald P. Sansone	E-986	9576

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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,480

Applicant(s)

SANSONE, RONALD P.

Examiner

Richard Woo

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

- 1) The terminal disclaimer and amendment filed January 21, 2003 are acknowledged.
- 2) Applicant's arguments, filed January 21, 2003, with respect to the rejections of the claims under 35 U.S.C. 102 as being anticipated by Kanevsky et al. or King et al. and under 103 as being unpatentable over Kara et al. in view of EP 1063602 have been fully considered and are persuasive.

However, in response to the applicant's argument that Smith et al. does not disclose or anticipate the step of notifying by the recipient to the data center of the manner in which the recipient wants some or all of their mail delivered, the examiner invites the applicant's attention to the paragraphs [0022]-[0023]. Smith et al. discloses that the user or recipient can select address (for business trip, it could be a hotel) and how many mail pieces the recipient may want to receive first or hold them at the post office (i.e. they could opt for receiving all or some of these mail pieces).

Claim Rejections - 35 USC § 112

- 3) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 4) Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, line 13, the recitation of "the data center" lacks antecedent basis.

Claim Rejections - 35 USC § 102

5) Claims 1-4, 6-7, 10-12, 16-18, 20, 24 and 27-34, as far as they are definite, are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (US 2002/0095306 A1 or US 2002/0042808 A1).

W.R.T. Claim 1:

Smith et al. discloses a method that enables a recipient to inform a carrier to deliver a mail in a plurality of manners, comprising the steps of:

depositing with the carrier mail containing the recipient's name and physical address and a sender's name and address (see Figs. and paragraphs [0022-0023]);

capturing the name and address of the recipient and the sender (see Figs. 5-8 for example and the descriptions thereof);

translating the name and address of the recipient into an e-mail address (see paragraph [0015] with respect to e-mail service);

notifying the recipient of the availability of the mail (see paragraphs [0017-0023]);

depositing with the carrier the mail;

notifying by the recipient to a data center to deliver the mail to the recipient in the manner specified by the recipient (paragraphs [0022-0023]);

notifying by the data center to the carrier of the manner in which the recipient wants the mail delivered (see *Id.*); and

delivering by the carrier mail to the recipient.

W.R.T. Claim 2: Smith et al. discloses the method wherein the recipient is notified of the estimated arrival time (paragraphs 0015-0025);

W.R.T. Claim 3: Smith et al. discloses the method wherein the recipient notifies the carrier to deliver the mail to a specified name and address (see Id.);

W.R.T. Claim 4: Smith et al. discloses the method wherein the recipient notifies the carrier to return the mail to the sender (paragraph 0021 for example);

W.R.T. Claims 6-7: Smith et al. discloses the method further including:

informing the carrier to e-mail the contents of the mail piece to the recipient;

mailing by e-mail the contents of mail piece;

informing the carrier to e-mail the contents of the mail piece to one or more specified e-mail addresses; and

mailing by e-mail to the specified e-mail address (paragraphs 0015-0023, 0033);

W.R.T. Claim 10: Smith et al. discloses the method wherein the recipient notifies the carrier to deliver the mail to the recipient at a different address;

W.R.T. Claims 11-12: Smith et al. discloses the method wherein the recipient notifies the carrier to deliver the mail to the recipient by a slower or faster delivery than normal one (see paragraphs 0015-0023);

W.R.T. Claims 16-17: Smith et al. discloses the method including: informing the sender of the delivery of the mail; and wherein the recipient notifies the carrier to hold the mail (see Id.);

W.R.T. Claim 18: Smith et al. discloses the method wherein the recipient notifies the carrier to destroy (or trash in Smith et al.) the mail (paragraph 0022);

W.R.T. Claim 20: Smith et al. discloses the method wherein the carrier is notified via e-mail;

W.R.T. Claim 24: Smith et al. discloses the method wherein the carrier is notified via e-mail;

W.R.T. Claim 27: Smith et al. discloses the method wherein the recipient notifies a data center as to notify the carrier;

W.R.T. Claims 28-32: Smith et al. must include the mail inherently containing a stamp, a postal indicia, permit and symbology; and

W.R.T. Claims 33-34: Smith et al. discloses the method wherein the graphic is captured and translated and stored (see paragraph 0015, view "image").

Claim Rejections - 35 USC § 103

6) Claims 5, 8-9, 13-15, 19, 21-23 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al..

Smith et al. discloses the method as cited above but does not specifically disclose the method including the limitations in Claims 5, 8-9, 13-15, 19, 21-23, 25-26 and 33-34 (opening the mail, using facsimile, how to charge, recycling the mail, telephoning, notifying via television).

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to arrange to open the mail, notify via a facsimile, telephone or television, charge the recipient for the service and recycle the mail because Applicant has not disclosed that the above claimed limitations provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the method of Smith et al. because one of ordinary skill in the art may adopt other notification manners and incorporate them into the existing notification system of Smith et al...

Therefore, it would have been an obvious matter of design choice to modify the invention of Smith et al. to obtain the invention as specified in claims 5, 8-9, 13-15, 19, 21-23 and 25-26.

Conclusion

7) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"U.S. Postal Service eyes the web for growth the postal agency wants to offer all U.S. residents an e-mail address to track and reroute their mail online" is cited to show that a customer can be notified by e-mail about an incoming package or a bill, and the

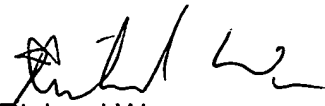
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customer could order the postal service to redirect the mail to different addresses through the internet.

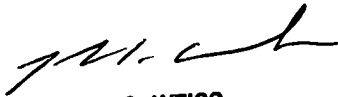
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
Patent Examiner
GAU 3629
January 23, 2004



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
JAN 23 2004 3600